

### **REMARKS/ARGUMENTS**

The office action of June 19, 2003 has been carefully reviewed and these remarks are responsive thereto. New claims 51-56 have been added. Claims 1-27, 29-42, 44-46, 48-56 remain pending. Reconsideration and allowance of the instant application are respectfully requested.

#### ***Rejections Under 35 U.S.C. § 103***

Claims 1, 3, 11-15, 21-22, 30-42, 44, 46, 49, and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford *et al.* (U.S. Pat. No. 6,502,113 B1, hereinafter Crawford). Applicant respectfully traverses this rejection for the following reasons.

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. See MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

#### **Motivation to Modify**

The present inventive system as described in the specification teaches a system and method for two or more parties to complete a real estate transaction, such as a lease, from initial negotiations to contract preparation to performance of contract provisions. That is, the system manages a transaction having multiple (e.g., nine) phases between two or more parties. Phases can include proposal, scheduling, business issues, tenant environment definition, legal documents, monitoring and scheduling of performance, evaluation. Each lease is negotiated using a computer-implemented process that guides the parties through the various negotiation phases. Parties to the transaction may answer predefined questions regarding a proposed transaction in such a manner that certain aspects of the transaction can be agreed upon early during the negotiation process while others are deferred to later phases. The parties must either agree or defer to all milestone decisions. This acknowledges that milestones may be used to complete the project or transaction, and that it is useful to avoid the dead-end implied by using the word "no" (which is considered

impolite or is non-existent in some cultures). Because both parties are forced to conform to a highly structured, well-defined transaction sequence for negotiation, errors and misunderstandings can be greatly reduced.

In contrast, Crawford describes an online system whereby two parties collaborate to edit a *specific document* having a plurality of negotiable clauses (abstract, emphasis added). The Crawford system uses a base document as a default position from which to begin online collaboration between the parties (Crawford, col. 8, lines 61-63). The parties each review the document online and suggest changes and amendments to the actual text of the document (Crawford, col. 12, line 19 – col. 13, lines 5). Crawford allows for detailed editing of intricate contract language without incurring delays normally associated with substantial revisions (col. 12, lines 40-42). Crawford does not teach, suggest, or support the notion of a transaction having multiple, distinct phases.

Applicant submits that there is no motivation to modify the teachings of Crawford with the level of knowledge of one of ordinary skill in the art to arrive at the present invention because Crawford *teaches away* from the inventive methods and systems. Specifically, Crawford admits that the Crawford system “virtually abolishes the kind of crunch strategies which are bound up with aggressive win/lose negotiations. In other words, this program helps negotiators avoid the so-called “Japanese” type of turn taking evasion, in which bottom line judgments are avoided....” Thus, Crawford specifically discourages deferring answering a question, whereas it is an aspect of the present invention that non-agreed provisions are deferred to a later phase of negotiation.

The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Thus, Applicants respectfully submit that that there is no motivation or suggestion to modify Crawford, which describes a system for editing a specific document, to arrive at the present invention, which manages an entire transaction. Likewise,

because Crawford teaches away from the present invention, Crawford cannot be used in any combination to support a rejection in this case.<sup>1</sup> This rejection is respectfully traversed.

Lack of Teaching All Claim Limitations

Even if Crawford is modified, the modification does not teach or suggest all the claim limitations of any claim. For example, claim 1 recites, *inter alia*, “displaying on a computer screen a plurality of lease provisions and a plurality of predefined actions associated with each lease provision.” Crawford does not teach or suggest a plurality of predefined actions associated with *each* lease provision—Crawford (at best) describes a plurality of predefined actions associated with *all* contract provisions. That is, the same actions are associated with all contract provisions in Crawford, whereas there are separate action elements, even if similar or identical, for each lease provision in the present invention.

Claim 1 also recites, *inter alia*, “the plurality of lease provisions are associated with a first phase of a lease negotiation... deferring non-agreed lease provisions to a later phase of the lease negotiation.” Crawford does not teach or suggest multiple phases as defined in the present application. Crawford only teaches or suggests a single phase as defined in the present application. Specifically, Crawford only teaches, suggests, or describes actions that may occur during a single phase (e.g., phase five) of the present invention. Claim 1 is thus allowable over Crawford because Crawford, even when combined with the level of knowledge of one of ordinary skill in the art, does not teach or suggest every limitation of claim 1.

Dependent claims 2-13 are allowable for at least the same reasons as independent claim 1. In addition, with respect to claim 12, Crawford does not teach or suggest automatically generating an intermediate document that summarizes points of agreement. Crawford, at best, prepares a revised version of the actual document, not an intermediate document that summarizes points of agreement.

Independent claim 14, similar to claim 1, recites, *inter alia*, “a plurality of predefined actions associated with each lease provision, wherein the plurality of lease provisions are associated with a first phase of a lease negotiation” and “defers non-agreed lease provisions to a later phase of the lease negotiation.” Claim 14 is thus allowable for similar reasons as claim 1.

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<sup>1</sup> In addition, the Examiner who signed the Office Action also signed the International Search Report, which indicated that the Crawford reference is not considered to be of particular relevance.

Dependent claims 15-22 are allowable for at least the same reasons as independent claim 14. In addition, with respect to claim 22, Crawford does not teach or suggest automatically generating an intermediate document that summarizes points of agreement.

Independent claim 30, recites, *inter alia*, “displaying on a computer screen a plurality of predefined real estate agreement provisions each relating to one aspect of a potential real estate agreement.” Similar to claim 1, the predefined actions in Crawford relate to more than one aspect of a potential agreement. In addition, Crawford does not teach or suggest a real estate agreement, and cannot be combined with the level of skill of one of ordinary skill in the art, as described above.

Dependent claims 31-37 and 46 are allowable for at least the same reasons as independent claim 30. In addition, with respect to claim 32, Crawford does not teach or suggest distinct negotiation phases.

With respect to claim 34, Crawford does not teach or suggest “during a later negotiation period, re-displaying real estate agreement provisions for which agreement was not reached during the first negotiation period, and repeating steps (2) and (3) for all such provisions.”

Independent claim 38, similar to claim 30, recites, *inter alia*, “a plurality of predefined agreement provisions each relating to one aspect of a potential agreement.” Claim 38 is therefore allowable for similar reasons as claim 32.

Dependent claims 39-42 and 44-45 are allowable for at least the same reasons as independent claim 38. In addition, with respect to claim 39, Crawford does not teach or suggest distinct negotiation phases.

With respect to claim 42, Crawford does not teach or suggest “during a later negotiation period, re-displaying agreement provisions for which agreement was not reached during the first negotiation period, and repeating steps (1) through (4) for all such provisions.”

With respect to claim 44, Crawford does not teach or suggest the use of an “ancillary value” as described in the claim.

Independent claim 49 and 50, similar to claim 30, each recite, *inter alia*, “a plurality of predefined agreement provisions each relating to one aspect of a potential agreement.” Claims 49 and 50 are thus allowable for similar reasons as claim 30.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Hoyt *et al.* (U.S. Pat. No. 6,067,531, hereinafter Hoyt). Applicant respectfully traverses this rejection for the following reasons.

Claim 2 is allowable for at least the same reasons as its independent base claim 1. In addition, Crawford cannot properly be combined with Hoyt (as discussed above) and, even if they are combined, Hoyt does not cure the deficiencies with Crawford. Hoyt describes a system that can indicate when a contract clause is incomplete or in error, but Hoyt does not require a user to select an AGREE or DEFER choice as recited in the claim (Hoyt, col. 31, ll. 11-14).

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Rickard *et al.* (U.S. Pat. No. 6,112,189, hereinafter Rickard). Applicant respectfully traverses this rejection because claim 4 is allowable for at least the same reasons as its independent base claim 1, because Crawford cannot properly be combined with Rickard (as discussed above) and, even if they are combined, Rickard does not cure the deficiencies of Crawford.

Claims 5, 6, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Boesch *et al.* (U.S. Pat. No. 5,897,621, hereinafter Boesch). Applicant respectfully traverses this rejection because each rejected dependent claim is allowable based on the allowability of their respective independent claims, Crawford cannot properly be combined with Boesch (as discussed above) and, even if they are combined, Boesch does not cure the deficiencies of Crawford.

Claims 7-10, 18-20 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Raveis, Jr. (U.S. Pat. No. 6,321,202, hereinafter Raveis). Applicant respectfully traverses this rejection for at least the following reasons.

Dependent claims 7-10 and 18-20 are allowable based on the allowability of their respective independent claims, because Crawford cannot properly be combined with Raveis (as

discussed above) and, even if they are combined, Raveis does not cure the deficiencies of Crawford.

In addition, claim 29, similar to claim 30 (above), recites, *inter alia*, “a plurality of lease provisions and a plurality of predefined actions associated with each lease provision.” Claim 29 is thus allowable for similar reasons as claim 30, because Raveis does not cure the deficiencies of Crawford.

Claims 23, 27 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Luke *et al.* (U.S. Pat. No. 6,131,087, hereinafter Luke). Applicant respectfully traverses this rejection for at least the following reasons.

Crawford cannot properly be combined with Luke (as discussed above) and, even if they are combined, Luke does not cure the deficiencies of Crawford. Also, similar to claim 30, discussed above, independent claims 23 and 48 each recite, *inter alia*, “a plurality of lease provisions and a plurality of predefined actions associated with each lease provision.”

Claim 27, dependent on claim 23, is allowable at least for the same reasons as claim 23 as discussed above.

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Luke and Raveis. This combination is improper, as discussed above. Also, Raveis does not cure the deficiencies of Crawford and/or Luke, and claim 24 is therefore allowable for at least the same reasons as claim 23.

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Luke, Raveis, and Boesch. This combination is improper, as discussed above. Also, Raveis and Boesch, even if combined, do not cure the deficiencies of Crawford and/or Luke, and claim 25 is therefore allowable for at least the same reasons as its base claim 23.

Claims 26 and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford in view of Luke and Rickard. This combination is improper, as discussed above.

Also, Rickard does not cure the deficiencies of Crawford and/or Luke, and claims 26 and 45 are therefore allowable for at least the same reasons as their respective base claims.

*New Claims*

Applicant has added new claims 51 – 57, supported by the specification as filed, and allowable for at least the same reasons as discussed above.

**CONCLUSION**

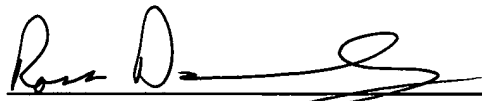
It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

BANNER & WITCOFF, LTD.

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